

### REMARKS

Claims 305-543 are pending in this application. Applicant has cancelled Claims 150-304, without prejudice, and Applicant has added new Claims 305-543. Applicant has also deleted the Abstract of the Disclosure and has substituted therefor the new Abstract of the Disclosure which is attached hereto on a separate sheet.

Applicant respectfully submits that the newly added Claims 305-543 do not contain new matter. Applicant further respectfully submits that the new Abstract of the Disclosure does not contain new matter.

Based on the foregoing amendments and the following Remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

#### I. THE 35 U.S.C. § 103 REJECTIONS:

The Examiner asserts that Claims 150-152, 154-159, 161, 162, 164-168, 170, 171, 174-192, 194, 197-205, 207-229, 231-236, 238-244, 246-248, 250-252, 271-280, 282-289, and 291-304 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Warady, et al., U.S. Patent No. 6,067,522 (Warady) in view of Asinof, Lynn, "Click & Shift: Workers Control Their Benefits On-line" (Asinof). The Examiner also asserts that Claims 160, 169, 193, 195, 196, 230 and 290 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warady and Asinof and further in view of Baker, III, U.S. Patent No. 5,864,822 (Baker). The Examiner also asserts that Claim 163 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warady and Asinof and further in view of Greengard, Samuel, "When HRMS goes global: Managing the data highway" (Greengard). The Examiner also asserts that Claims 172, 173, 206, 237, 245, 281 and 290 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warady and Asinof and further in view of the Examiner's use of Official Notice. The Examiner also asserts that Claims 253, 254, 256, 257, 269 and 270 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warady and "information available on the E-Benefits web page" (E-Benefits). The Examiner also asserts that Claims 255, 258-262 and 264-268 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warady and E-Benefits and further in view of Asinof. The Examiner also asserts that Claim 263 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warady, E-Benefits and Asinof and further in view of the Examiner's use of Official Notice. The Examiner also asserts that Claim 153 is rejected under 35

U.S.C. 103(a) as being unpatentable over Warady and Asinof and further in view of Williams, U.S. Patent No. 5,600,554 (Williams).

As noted above, Applicant has cancelled Claims 150-304, without prejudice, and Applicant has added new Claims 305-543. Applicant respectfully submits that the present invention, as defined by Claims 305-543, is patentable over the prior art.

**IA. THE PRESENT INVENTION, AS DEFINED BY CLAIMS 305-360, IS PATENTABLE OVER THE PRIOR ART:**

Applicant respectfully submits that the present invention, as defined by Claims 305-360, is patentable over the prior art.

Applicant respectfully submits that the present invention, as defined by independent Claim 305, is patentable over the prior art. Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest a computer-implemented method for providing employee benefits information, comprising receiving at least one of a request for an employee benefit and

a claim for an employee benefit, processing the at least one of a request for an employee benefit and a claim for an employee benefit with a processing device using employee benefits information stored in a database or memory device, wherein the employee benefits information comprises at least one of healthcare insurance information, disability insurance information, and life insurance information, and at least one of vacation time information, personal time information, and sick time information, generating a message in response to the at least one of a request for an employee benefit and a claim for an employee benefit, and transmitting the message to a communication device associated with at least one of an employee, a benefits beneficiary, an employer, and a benefits administrator, all of which features are specifically recited features of independent Claim 305.

In view of the above, Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest many of the specifically recited features of independent Claim 305. In view of the foregoing, Applicant respectfully submits that the present invention, as defined by independent Claim 305, is patentable over the prior art.

Applicant further respectfully submits that Claims 306-360, which claims depend either directly or indirectly from independent Claim 305, so as to include all of the limitations of independent Claim 305, are also patentable as said Claims 306-360 depend from allowable subject matter.

Allowance of pending Claims 305-360 is, therefore, respectfully requested.

**IB. THE PRESENT INVENTION, AS DEFINED BY CLAIMS 361-416,  
IS PATENTABLE OVER THE PRIOR ART:**

Applicant respectfully submits that the present invention, as defined by Claims 361-418, is patentable over the prior art.

Applicant respectfully submits that the present invention, as defined by independent Claim 361, is patentable over the prior art. Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest a computer-implemented method for providing employee benefits information, comprising

receiving at least one of a request for an employee benefit and a claim for an employee benefit, processing the at least one of a request for an employee benefit and a claim for an employee benefit with a processing device using employee benefits information stored in a database or memory device, wherein the employee benefits information comprises at least one of pension benefits information and retirement benefits information, and at least one of vacation time information, personal time information, and sick time information, generating a message in response to the at least one of a request for an employee benefit and a claim for an employee benefit, and transmitting the message to a communication device associated with at least one of an employee, a benefits beneficiary, an employer, and a benefits administrator, all of which features are specifically recited features of independent Claim 361.

In view of the above, Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest many of the specifically recited features of independent Claim 361. In view of the foregoing, Applicant respectfully submits that the present invention, as defined by independent Claim 361, is patentable over the prior art.

Applicant further respectfully submits that Claims 362-416, which claims depend either directly or indirectly from independent Claim 361, so as to include all of the limitations of independent Claim 361, are also patentable as said Claims 362-416 depend from allowable subject matter.

Allowance of pending Claims 361-416 is, therefore, respectfully requested.

**IC. THE PRESENT INVENTION, AS DEFINED BY CLAIM 417,  
IS PATENTABLE OVER THE PRIOR ART:**

Applicant respectfully submits that the present invention, as defined by independent Claim 417, is patentable over the prior art.

Applicant respectfully submits that the present invention, as defined by independent Claim 417, is patentable over the prior art. Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest a computer-implemented method for providing employee benefits information, comprising

receiving at least one of a request for an employee benefit and a claim for an employee benefit, processing the at least one of a request for an employee benefit and a claim for an employee benefit with a processing device using employee benefits information stored in a database or memory device, wherein the employee benefits information comprises at least one of healthcare insurance information, disability insurance information, and life insurance information, at least one of pension benefits information and retirement benefits information, and at least one of vacation time information, personal time information, and sick time information, generating a message in response to the at least one of a request for an employee benefit and a claim for an employee benefit, and transmitting the message to a communication device associated with at least one of an employee, a benefits beneficiary, an employer, and a benefits administrator, all of which features are specifically recited features of independent Claim 417.

In view of the above, Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest many of the specifically recited features of independent Claim 417. In view of the



foregoing, Applicant respectfully submits that the present invention, as defined by independent Claim 417, is patentable over the prior art.

Allowance of pending Claim 417 is, therefore, respectfully requested.

**ID. THE PRESENT INVENTION, AS DEFINED BY CLAIM 418,  
IS PATENTABLE OVER THE PRIOR ART:**

Applicant respectfully submits that the present invention, as defined by independent Claim 418, is patentable over the prior art.

Applicant respectfully submits that the present invention, as defined by independent Claim 418, is patentable over the prior art. Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest a computer-implemented method for providing employee benefits information, comprising receiving at least one of a request for an employee benefit and a claim for an employee benefit, processing the at least one of a request for an employee benefit and a claim for an employee

benefit with a processing device using employee benefits information stored in a database or memory device, wherein the employee benefits information comprises at least one of healthcare insurance information, disability insurance information, and life insurance information, and at least one of vacation time information, personal time information, sick time information, educational assistance benefit information, tuition reimbursement benefit information, credit union benefit information, employee discount program benefit information, buying service benefit information, and stock option benefit information, generating a message in response to the at least one of a request for an employee benefit and a claim for an employee benefit, and transmitting the message to a communication device associated with at least one of an employee, a benefits beneficiary, an employer, and a benefits administrator, all of which features are specifically recited features of independent Claim 418.

In view of the above, Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest many of the specifically recited features of independent Claim 418. In view of the foregoing, Applicant respectfully submits that the present

invention, as defined by independent Claim 418, is patentable over the prior art.

Allowance of pending Claim 418 is, therefore, respectfully requested.

IE. THE PRESENT INVENTION, AS DEFINED BY CLAIM 419,  
IS PATENTABLE OVER THE PRIOR ART:

Applicant respectfully submits that the present invention, as defined by independent Claim 419, is patentable over the prior art.

Applicant respectfully submits that the present invention, as defined by independent Claim 419, is patentable over the prior art. Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest a computer-implemented method for providing employee benefits information, comprising receiving at least one of a request for an employee benefit and a claim for an employee benefit, processing the at least one of a request for an employee benefit and a claim for an employee benefit with a processing device using employee benefits information stored in a database or memory device, wherein the

employee benefits information comprises at least one of pension benefits information and retirement benefits information, and at least one of vacation time information, personal time information, sick time information, educational assistance benefit information, tuition reimbursement benefit information, credit union benefit information, employee discount program benefit information, buying service benefit information, and stock option benefit information, generating a message in response to the at least one of a request for an employee benefit and a claim for an employee benefit, and transmitting the message to a communication device associated with at least one of an employee, a benefits beneficiary, an employer, and a benefits administrator, all of which features are specifically recited features of independent Claim 419.

In view of the above, Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest many of the specifically recited features of independent Claim 419. In view of the foregoing, Applicant respectfully submits that the present invention, as defined by independent Claim 419, is patentable over the prior art.

Allowance of pending Claim 419 is, therefore, respectfully requested.

**IF. THE PRESENT INVENTION, AS DEFINED BY CLAIMS 420-467, IS PATENTABLE OVER THE PRIOR ART:**

Applicant respectfully submits that the present invention, as defined by Claims 420-467, is patentable over the prior art.

Applicant respectfully submits that the present invention, as defined by independent Claim 420, is patentable over the prior art. Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest a computer-implemented method for providing employee benefits information, comprising receiving a request for information regarding an employee benefit, processing the request for information regarding an employee benefit with a processing device using employee benefits information stored in a database or memory device, wherein the employee benefits information comprises information regarding an employee benefit associated with an employee, wherein the employee benefit exists from a previous relationship and is maintained by the employee in a current

employment relationship, wherein the employee benefit from the previous relationship is paid for or provided at least in part by a current employer pursuant to an employment relationship and is included in employee benefits provided to the employee by the current employer, generating a message in response to the request for information regarding an employee benefit, wherein the message contains a response to the request for information regarding an employee benefit, and transmitting the message to a communication device associated with at least one of the employee, a benefits beneficiary, an employer, and a benefits administrator, all of which features are specifically recited features of independent Claim 420.

In view of the above, Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest many of the specifically recited features of independent Claim 420. In view of the foregoing, Applicant respectfully submits that the present invention, as defined by independent Claim 420, is patentable over the prior art.

Applicant further respectfully submits that Claims 421-467, which claims depend either directly or indirectly from

independent Claim 420, so as to include all of the limitations of independent Claim 420, are also patentable as said Claims 421-467 depend from allowable subject matter.

Allowance of pending Claims 420-467 is, therefore, respectfully requested.

**IG. THE PRESENT INVENTION, AS DEFINED BY CLAIM 468,  
IS PATENTABLE OVER THE PRIOR ART:**

Applicant respectfully submits that the present invention, as defined by independent Claim 468, is patentable over the prior art.

Applicant respectfully submits that the present invention, as defined by independent Claim 468, is patentable over the prior art. Applicant respectfully submits that, Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest a computer-implemented method for providing employee benefits information, comprising receiving a request for information regarding an employee benefit, processing the request for information regarding an employee benefit with a processing device using employee

benefits account information stored in a database or memory device, wherein the employee benefits account information comprises information regarding an employee benefit associated with an employee, wherein the employee benefit exists from a previous relationship and is maintained by the employee in a current employment relationship, wherein the employee benefit from the previous relationship is paid for or provided at least in part by a current employer pursuant to an employment relationship and is included in employee benefits provided to the employee by the current employer, generating a message in response to the request for information regarding an employee benefit, wherein the message contains a response to the request for information regarding an employee benefit, and transmitting the message to a communication device associated with at least one of the employee, a benefits beneficiary, an employer, and a benefits administrator, all of which features are specifically recited features of independent Claim 468.

In view of the above, Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest many of the specifically recited features of independent Claim 468. In view of the foregoing, Applicant respectfully submits that the present



invention, as defined by independent Claim 468, is patentable over the prior art.

Allowance of pending Claim 468 is, therefore, respectfully requested.

**IH. THE PRESENT INVENTION, AS DEFINED BY CLAIMS 469-516,  
IS PATENTABLE OVER THE PRIOR ART:**

Applicant respectfully submits that the present invention, as defined by Claims 469-516, is patentable over the prior art.

Applicant respectfully submits that the present invention, as defined by independent Claim 469, is patentable over the prior art. Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest a computer-implemented method for providing employee benefits information, comprising receiving at least one of a request for an employee benefit and a claim for an employee benefit, processing the at least one of a request for an employee benefit and a claim for an employee benefit with a processing device using employee benefits

information stored in a database or memory device, wherein the employee benefits information comprises information regarding an employee benefit associated with an employee, wherein the employee benefit exists from a previous relationship and is maintained by the employee in a current employment relationship, wherein the employee benefit from the previous relationship is paid for or provided at least in part by a current employer pursuant to an employment relationship and is included in employee benefits provided to the employee by the current employer, generating a message in response to the at least one of a request for an employee benefit and a claim for an employee benefit, wherein the message contains a response to the at least one of a request for an employee benefit and a claim for an employee benefit, and transmitting the message to a communication device associated with at least one of the employee, a benefits beneficiary, an employer, and a benefits administrator, all of which features are specifically recited features of independent Claim 469.

In view of the above, Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest many of the specifically recited features of independent Claim 469. In view of the

foregoing, Applicant respectfully submits that the present invention, as defined by independent Claim 469, is patentable over the prior art.

Applicant further respectfully submits that Claims 470-516, which claims depend either directly or indirectly from independent Claim 469, so as to include all of the limitations of independent Claim 469, are also patentable as said Claims 470-516 depend from allowable subject matter.

Allowance of pending Claims 469-516 is, therefore, respectfully requested.

**II. THE PRESENT INVENTION, AS DEFINED BY CLAIMS 517-520,  
IS PATENTABLE OVER THE PRIOR ART:**

Applicant respectfully submits that the present invention, as defined by Claims 517-520, is patentable over the prior art.

Applicant respectfully submits that the present invention, as defined by independent Claim 517, is patentable over the prior art. Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the

Examiner's use of Official Notice, and any combination of same, do not disclose or suggest a computer-implemented method for providing employee benefits information, comprising receiving at least one of a request for an employee benefit and a claim for an employee benefit, processing the at least one of a request for an employee benefit and a claim for an employee benefit with a processing device using employee benefits account information stored in a database or memory device, wherein the employee benefits account information comprises information regarding an employee benefit associated with an employee, wherein the employee benefit exists from a previous relationship and is maintained by the employee in a current employment relationship, wherein the employee benefit from the previous relationship is paid for or provided at least in part by a current employer pursuant to an employment relationship and is included in employee benefits provided to the employee by the current employer, generating a message in response to the at least one of a request for an employee benefit and a claim for an employee benefit, wherein the message contains a response to the at least one of a request for an employee benefit and a claim for an employee benefit, and transmitting the message to a communication device associated with at least one of the employee, a benefits beneficiary, an employer, and a

benefits administrator, all of which features are specifically recited features of independent Claim 517.

In view of the above, Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest many of the specifically recited features of independent Claim 517. In view of the foregoing, Applicant respectfully submits that the present invention, as defined by independent Claim 517, is patentable over the prior art.

Applicant further respectfully submits that Claims 518-520, which claims depend directly from independent Claim 517, so as to include all of the limitations of independent Claim 517, are also patentable as said Claims 518-520 depend from allowable subject matter.

Allowance of pending Claims 517-520 is, therefore, respectfully requested.

IJ. THE PRESENT INVENTION, AS DEFINED BY CLAIMS 521-536,  
IS PATENTABLE OVER THE PRIOR ART:

Applicant respectfully submits that the present invention, as defined by Claims 521-536, is patentable over the prior art.

Applicant respectfully submits that the present invention, as defined by independent Claim 521, is patentable over the prior art. Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest a computer-implemented method for providing employee benefits information, comprising storing employee benefits information in a database or memory device, detecting at least one of a change to a benefit, a change to or activity regarding a benefits account, an offering of a benefit, a posting of an offer to sell a benefit or a benefits package, and a posting of benefits information, wherein the at least one of a change to a benefit, a change to or activity regarding a benefits account, an offering of a benefit, a posting of an offer to sell a benefit or a benefits package, and a posting of benefits information, is automatically detected by a processing device, generating a message

containing information regarding the at least one of a change to a benefit, a change to or activity regarding a benefits account, an offering of a benefit, a posting of an offer to sell a benefit or a benefits package, and a posting of benefits information, wherein the message is automatically generated by the processing device upon the detection of the at least one of a change to a benefit, a change to or activity regarding a benefits account, an offering of a benefit, a posting of an offer to sell a benefit or a benefits package, and a posting of benefits information, and transmitting the message to a communication device associated with at least one of an employee and a benefits beneficiary, all of which features are specifically recited features of independent Claim 521.

In view of the above, Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest many of the specifically recited features of independent Claim 521. In view of the foregoing, Applicant respectfully submits that the present invention, as defined by independent Claim 521, is patentable over the prior art.

Applicant further respectfully submits that Claims 522-536, which claims depend directly from independent Claim 521, so as to include all of the limitations of independent Claim 521, are also patentable as said Claims 522-536 depend from allowable subject matter.

Allowance of pending Claims 521-536 is, therefore, respectfully requested.

**IK. THE PRESENT INVENTION, AS DEFINED BY CLAIMS 537-543,  
IS PATENTABLE OVER THE PRIOR ART:**

Applicant respectfully submits that the present invention, as defined by Claims 537-543, is patentable over the prior art.

Applicant respectfully submits that the present invention, as defined by independent Claim 537, is patentable over the prior art. Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest a computer-implemented method for providing employee benefits information, comprising storing employee benefits information in a database or memory device, detecting a posting of at least one of a need, a request, and



a requirement, to buy or to obtain at least one of a benefit, a benefits package, and benefits information, wherein the posting of at least one of a need, a request, and a requirement, to buy or to obtain at least one of a benefit, a benefits package, and benefits information, is automatically detected by a processing device, generating a message containing information regarding the posting of at least one of a need, a request, and a requirement, to buy or to obtain at least one of a benefit, a benefits package, and benefits information, wherein the message is automatically generated by the processing device upon the detection of the posting of at least one of a need, a request, and a requirement, to buy or to obtain at least one of a benefit, a benefits package, and benefits information, and transmitting the message to a communication device associated with a benefit provider, all of which features are specifically recited features of independent Claim 537.

In view of the above, Applicant respectfully submits that Warady, Asinof, Baker, Greengard, E-Benefits, Williams, the Examiner's use of Official Notice, and any combination of same, do not disclose or suggest many of the specifically recited features of independent Claim 537. In view of the foregoing, Applicant respectfully submits that the present

invention, as defined by independent Claim 537, is patentable over the prior art.

Applicant further respectfully submits that Claims 538-543, which claims depend directly from independent Claim 537, so as to include all of the limitations of independent Claim 537, are also patentable as said Claims 538-543 depend from allowable subject matter.


Allowance of pending Claims 537-543 is, therefore, respectfully requested.

## II. CONCLUSION:

In view of the foregoing, the application is deemed to be in condition for allowance and action to that end is respectfully requested. Allowance of pending Claims 305-543 is, therefore, respectfully requested.

A Credit Card Payment Form for payment of \$799.00, for payment for eighty four (84) additional claims (\$765.00) and for one (1) additional independent claim (\$43.00), is submitted herewith. A Fee Transmittal Sheet (in duplicate) is also submitted herewith.

Respectfully Submitted,

  
Raymond A. Joao  
Reg. No. 35,907

Encls.: - Abstract of the Disclosure  
- A Credit Card Payment Form for payment of \$799.00 for payment for eighty four (84) additional claims (\$765.00) and for one (1) additional independent claim (\$43.00)  
- Fee transmittal Sheet (in duplicate)  
- Return Receipt Postcard

November 21, 2003  
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